

Applicant: William Galbraith
Application No.: 10/804,592
Amendment to Office Action dated November 3, 2006
Docket No.: P-6007/1 (102-585)
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REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-6 and 24-31 are in the application. Claims 1 and 24 have been amended, respectively, to incorporate dependent claims 50 and 51. Accordingly, claims 50 and 51 have been cancelled. It is respectfully submitted that these amendments do not raise new issues or require additional searching and, thus, should be properly entered.

It is noted that in the Official Action, claims 50 and 51 were only rejected under 35 U.S.C. §103(a). With claims 1 and 24 having been amended to incorporate claims 50 and 51, it is respectfully submitted that all other rejections, including the double patenting rejection, have been overcome. The previous rejection of claims 50 and 51 will be discussed in the context of claims 1 and 24, respectively.

Claims 50 and 51 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Grahnen et al. (Eur. J. Biochem. 80, 573-580 (1977)) in view of Matzinger et al. (U.S. Patent No. 6,680,176) further in view of Shi et al. (U.S. Patent No. 5,919,626). The Examiner admitted that Grahnen et al. "fails to teach the ligand attached via an epoxy linkage." The Examiner relied on Matzinger et al. for allegedly disclosing an epoxy linkage.¹ The Examiner further relied on Shi et al. for the alleged notion "that an epoxy linkage to a receptor agent is beneficial because the linkages are stable to heat, high salt and elevated temperatures". The Examiner argued that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the apparatus of Grahnen et al., to the hydroxy group on the ligand to the substrate via an epoxy linkage as taught by [Matzinger et al.], in order to provide linkages that are stable in heat and elevated temperatures as taught by Shi et al."

¹ It is noted that at p. 5 of the Office Action, the Examiner refers to Ebersole et al. It appears that the Examiner, in fact, is referring to Matzinger et al. If Applicant's understanding is incorrect, Applicants request a further opportunity to respond to this rejection.

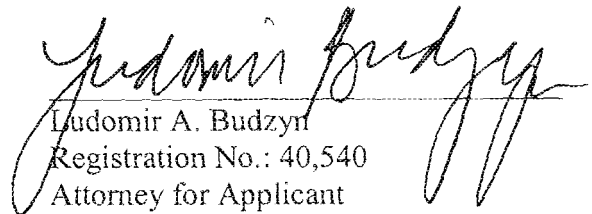
The Examiner's assertions are respectfully traversed.

Applicant is in full agreement that Grahnen et al. fails to disclose an epoxy linkage. Grahnen et al. discloses the "coupling" of bromosulphophthalein to Sepharose CL-4B (which is Sepharose 4B cross-linked with 2, 3-dibromopropanol). (See bottom of first col. on p. 574 of Grahnen et al.). Matzinger et al. generically discloses the use of "epoxy activated matrices". (Col. 16, l. 13). There is no disclosure, however, how such an epoxy activated matrix is to be used with the cross-linked version of Sepharose of Grahnen et al. There is no disclosure or suggestion that an epoxy linkage can be substituted into the method of Grahnen et al. successfully as suggested by the Examiner. Chemistry is highly unpredictable, particularly the behavior of molecules and their reactions are highly unpredictable. Thus, there is no basis for determining that the hypothetical combination suggested by the Examiner can be achieved. Shi et al. does not overcome the deficiencies of Grahnen et al. and Matzinger et al. It is impermissible hindsight to rely on Applicant's claims as a roadmap for piecing together a rejection. It is respectfully submitted that claims 1 and 24, along with dependent claims 2-6 and 25-31, respectively, are patentable over Grahnen et al., Matzinger et al. and Shi et al., each taken alone or in combination.

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Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant's attorney at the number listed below.

Respectfully submitted,


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